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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,412	02/13/2001	Gary P. Mousseau	1400-1072 D5	3123
54120	7590	01/28/2008		
RESEARCH IN MOTION ATTN: GLENDA WOLFE BUILDING 6, BRAZOS EAST, SUITE 100 5000 RIVERSIDE DRIVE IRVING, TX 75039			EXAMINER STRANGE, AARON N	
			ART UNIT 2153	PAPER NUMBER
			MAIL DATE 01/28/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No.		Applicant(s)	
	09/782,412		MOUSSEAU ET AL.	
	Examiner		Art Unit	
	Aaron Strange		2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-78 and 89-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-78 and 89-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In the interest of expedited prosecution, the Examiner would like to recommend conducting an interview prior to filing a response to the present Office action, possibly at the same time as an interview to discuss related application 09/782,107. The Examiner feels that an interview would be beneficial in identifying potentially allowable subject matter and/or issues for appeal. If Applicant agrees that an interview would be beneficial, he/she is encouraged to contact the Examiner to schedule one.

Response to Arguments

2. Applicant's arguments with respect to claims 65-78 and 89-118 have been considered but are moot in view of the new ground(s) of rejection in view of Mosher and 35 U.S.C. §112, first paragraph, set forth below.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification makes no reference to the term "computer-accessible medium", which appears in claims 108-118. Applicant must amend the specification to provide clear support or antecedent basis for the term, taking care to ensure that no new matter is introduced.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 97-107 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. Claims 97-107 recite a system claim comprising a plurality of "means for" performing various functions. The specification of the present application discloses that redirector program performs these functions (Specification, 4-8). Since the redirector program is a software program, the disclosure would have suggested to one of ordinary skill in the art that the claimed means are intended to include-only embodiments. Since the claim is not limited to statutory subject matter, it is non-statutory.

Additionally, it is noted that claims 108-118 contain limitations directed to a "code portion for" performing the same functionality as that claimed in claims 97-107. When considered in combination with the language of claims 97-107 and the content of the specification, these provide further evidence that the claimed means are intended to include software per se.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 65-78 and 89-118 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

9. With regard to independent claim 65, the limitation "combining the follow-up message with the data item into a response message that identifies the e-mail address of the user as an originating address for the response message" is not described in the specification. The Examiner has thoroughly reviewed the specification, and cannot locate any description of combining a follow up message with the data item (which includes an e-mail message and an attachment) into a response message.

10. Independent claims 89, 97 and 108 contain a substantially identical limitation and are rejected under the same rationale.

11. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 65, 67-70, 89, 97, 99, 108 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Mosher ("Microsoft Exchange User's Handbook").

14. The Examiner would like to note that the Mosher reference is an excerpt of a book. Only the portion of the book relied upon has been included with the present Office action since the entire book is several hundred pages in length, most of which are not pertinent to the present rejection.

15. With regard to independent claim 65, Eggleston disclosed a method of redirecting e-mail messages and message attachments to a user of a mobile data communication device that is associated with a host system and communicates therewith, the user having an e-mail address associated with the host system (users have email accounts)(col. 6, ll. 59-61) the method comprising:

receiving a data item (email) for the user at the host system (server 115), the data item including an e-mail message addressed to the user and a message attachment (e.g. email message with attachment, Col 8, lines 30-37);

redirecting at least a portion of the e-mail message from the host system to the mobile data communication device via a wireless network (e.g. when the user has implemented a filter and only part of the message is sent to the user, see inter alia Col 3, lines 23-26 and Col 10, lines 10-32);

receiving a first command message from the mobile data communication device at the host system requesting more of the data item (i.e. sends the request after receiving partial or summary data for more of the message or all of the message, see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

redirecting the message attachment from the host system to the mobile data communication device via the wireless network in response to first command message (i.e. when the user requests all of the message or full transfer of the message, the attachment will also be sent to the user's mobile device, again see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

receiving from the mobile data communication device a follow-up message and a follow-up addressee (user replies to a message)(col. 3, ll. 35-56); and

sending the follow-up message to the follow-up addressee (col. 3, ll. 46-47).

However, Eggleston fails to specifically disclose combining the follow-up message with the data item including the original message and the attachment into a

response message and forwarding the response message to the follow-up addressee using the user's e-mail address as an originating address for the response message.

Mosher discloses a similar system for transmitting email messages to users. Mosher teaches forwarding messages, wherein the forwarded messages will contain the text of the incoming message, any attachments to the incoming message, and a follow-up note. These messages are then sent to a new addressee and contain the originating address of the user sending the response since the message is created as a new message. (See p. 290, "Forwarding Messages"). This would have been an advantageous addition to the system disclosed by Eggleston since it would have allowed messages containing attachments to be sent to a third party by a message recipient without requiring them to regenerate the entire message.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permit forwarding of messages in the manner taught by Mosher to allow a message recipient to share a received message with a third party without being require to regenerate the entire message.

16. With regard to claims 67, Eggleston disclosed:

Configuring one or more redirection events at the host system (e.g. user sets up a filter, see inter alia Col 8, lines 14-55);

detecting that a redirection event has occurred at the host system (i.e. an email passes the filter criteria) and generating a redirection trigger (required internally in the

system such that the system invokes the process or procedure to actually forward the message); and

In response to the redirection trigger, redirecting at least a portion of the e-mail message from the host system to the mobile data communication device (i.e. forwarding the message when it passes the filter criteria).

17. With regard to claims 68 and 69, Eggleston disclosed the external redirection event is a message from the mobile data communication device to start the redirection step (i.e. user enables the filters from the mobile device, Col 9, lines 32-43). Eggleston also disclosed the internal event includes a calendar alarm (calendar activates a filter profile, Col 9, lines 42-43).

18. With regard to claim 70, Eggleston disclosed the mobile data communication device is one of a hand-held wireless paging computer, a wirelessly-enabled palm-top computer, a mobile telephone with data message capabilities and a wirelessly-enabled laptop computer (Col 4, lines 11-13).

19. Claims 89, 97, 99, 108 and 110 are rejected under the same rationale as claims 65 and 70, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

20. Claims 71-73, 91-93, 100-102 and 111-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Mosher ("Microsoft Exchange User's Handbook") further in view of Official Notice.

21. With regard to claims 71-73, while the system disclosed by Eggleston in view of Mosher shows substantial features of the claimed invention (discussed above), it fails to disclose that the attachment is one of a word processing, audio or video attachment, or whether the attachment is one that can be processed by the mobile device.

The Examiner takes Official Notice that word processing files, audio files, and video files were all old and well known types of email attachments at the time the invention was made, and that word processing type files could be processed (displayed) by mobile devices while video files could not, due to limitations on processing capabilities at the time.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permit these attachments to be received and processed by the system taught by Eggleston and Mosher, since they were commonly accepted email attachments at the time the invention was made.

22. Claims 91-93, 100-102 and 111-113 are rejected under the same rationale as claims 71-73, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

23. Claims 66, 74-78, 90, 94-96, 98, 103-107, 109 and 114-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Eggleston et al. (US 5,958,006) in view of Mosher ("Microsoft Exchange User's Handbook") further in view of Official Notice further in view of Kikinis (US 5,964,833).

24. With regard to claims 66 and 74, while the system disclosed by Eggleston and Mosher shows substantial features of the claimed invention (discussed above), it fails to disclose receiving a second command message from the mobile data communication device at the host system to send the message attachment to an external device stored in a user profile and redirecting the message attachment from the host system to the external device in response to the second command message.

In a similar messaging system Kikinis disclosed a system that allows users to forward email attachments to various preprogrammed external devices such as a fax machine (Kikinis Col 4, lines 50-56). By allowing users to forward attachments using other devices rather than just email, Kikinis allows users to communicate easier and with more people. For instance an external device such a fax machine may be more convenient for some users or the only form of communication available to other users who are unable to receive email at a particular location.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Eggleston's system to allow users to forward attachments to other preprogrammed external devices, as disclosed by Kikinis, so that

users can communicate with other people by using different means rather than just email and thus communicate with more people.

25. With regard to claim 75, Kikinis disclosed the external device is one of a fax machine (Col 4, lines 50-56).

26. With regard to claim 76, Kikinis disclosed the step of decoupling the message attachment from the e-mail message (i.e. Kikinis only sends the attachment to a fax machine which requires decouple the message attachment from the e-mail message).

27. With regard to claims 77 and 78, Kikinis disclosed the step of storing the e-mail message and message attachment in a message store at the host system (Col 4, lines 38-48).

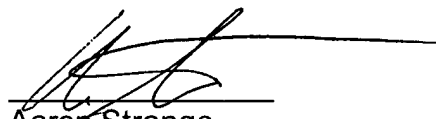
28. Claims 90, 94-96, 98, 103-107, 109 and 114-118 are rejected under the same rationale as claims 66, 74-78, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Conclusion

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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GAU 2153
1/24/2008